

MAY 17 2001



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
www.uspto.gov

Elizabeth A. Hanley
LaHive & Cockfield, LLP
28 State Street
Boston, MA 02109

In re Application of	:
Gee-Kee Sim et al.	:
Application No.: 09/646,561	:
PCT No.: PCT/US99/06187	:
Int. Filing Date: 19 March 1999	:
Priority Date: 19 March 1998	:
Attorney's Docket No.: HKZ-029CPUS	:
For: T CELL COSTIMULATORY PROTEINS,	:
SEQUENCES AND USES THEREOF	:

DECISION ON

PETITION

UNDER 37 CFR 1.47(a)

This is a decision in response to the declaration and petition filed under 37 CFR 1.47(a) on 01 February 2001, to accept the application without the signature of co-inventor Gee-Kee Sim. The required \$130 petition fee has been received.

BACKGROUND

On 19 March 1999, applicants filed international application PCT/US99/06187, which claimed priority of an earlier US application filed 17 April 1998 and an earlier provisional application filed 19 March 1998. A copy of the international application was communicated to the United States Patent and Trademark Office from applicant on 19 September 2000. A Demand for international preliminary examination, in which the United States was elected, was filed on 19 October 1999. Accordingly, the thirty month period for paying the basic national fee in the United States expired at midnight on 19 September 2000.

On 19 September 2000, applicant filed a transmittal letter for entry into the national stage in the United States which was accompanied by, inter alia, the requisite basic national fee as required by 35 U.S.C. 371(c).

On 01 November 2000, the United States Designated/Elected Office mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (Form PCT/EO/EO905), indicating that an oath or declaration and the surcharge for filing the

oath or declaration later than 30 months from the priority date as required by 37 CFR 1.492(e) needed to be filed. The notification set a one month time period in which to respond.

In response to the Form PCT/DO/EO/905, on 01 February 2001, applicant filed the following papers:

- 1) a transmittal letter;
- 2) a petition under 37 CFR 1.47 (a) and the required petition fee;
- 3) the required surcharge for filing the declaration later than 30 months from the earliest priority date;
- 4) declarations/powers of attorney signed by inventors Karen S. Sellers and Shumin Yang;
- 5) a declaration signed by Susan A. Gordon concluding that Dr. Sim had not signed a declaration and assignment and giving Dr. Sim's last known address; and
- 6) A petition and fee for a two-month extension of time.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

With respect to item (1), the \$130 petition fee under 37 CFR 1.17(h) was included with the petition. The petition is missing item (2). With respect to item (3), Ms. Gordon has given a statement of Dr. Sim's last known address. Regarding item (4), applicants included a Declaration signed by two of the three co-inventors. The nonsigning co-inventor's name, residence, post office address and citizenship are typed on the declaration. This declaration satisfies the requirements of section 409.03(a) of the Manual of Patent Examining Procedure (MPEP) and is in compliance with 37 CFR 1.497(a) and (b). Thus, item (4) has been satisfied.

With respect to item (2) above, Ms. Gordon has stated that "On November 8, 2000, I sent a letter by Federal Express to Dr. Sim at 543 Franklin Street, Denver, Colorado (which is the address of her known acquaintance, Dr. Andre Augustine), enclosing a Declaration and Assignment for the above-mentioned patent application requesting that she sign the documents and return them to Heska in the return Federal Express envelope provided. To date I have not received the documents." Further, Ms. Gordon has stated, "On December 22, 2000, I sent a another letter by Certified Mail on

behalf of Carol Talkington Verser, PhD. to Dr. Sim at 543 Franklin Street, Denver, Colorado, enclosing another copy of the Declaration and Assignment for the above-referenced patent application requesting that she sign the documents and return them to Dr. Verser in the return FedEx package provided. To date we have not received the signed documents, nor have we received the Certified letter return receipt requested."

It is first noted that there is an inconsistency between the date indicated in paragraph 6 of Ms. Gordon's declaration and the Federal Express receipt (Exhibit B). Ms. Gordon's declaration alleges that the letter was sent to Dr. Sim by Federal Express on November 8, 2000. However, the Federal Express receipt indicates that a package was mailed on December 8, 2000. Applicant is required to explain this inconsistency.

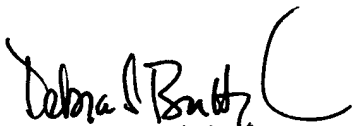
Before a refusal can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings and oath or declaration) to the non-signing inventor for signature. Ms. Gordon's declaration does not state whether a complete copy of the application was sent to Dr. Sim. Further, the letters to Dr. Sim, dated November 8, 2000 and December 22, 2000, only refer to the enclosed declaration and assignment documents. The application papers are not mentioned.

CONCLUSION

The petition under 37 CFR 1.47(a) is DISMISSED.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C., 20231, with the contents of this letter marked to the attention of the PCT Legal Office.



Debra S. Brittingham
PCT Special Programs Examiner
PCT Legal Office

Conferee:



Boris Milef
PCT Legal Examiner
PCT Legal Office

DSB/BM:dsb

Telephone: (703) 308-3401

Facsimile: (703) 308-6459